REMARKS/ARGUMENTS

This amendment responds to the Office Action dated October 31, 2007 in which the Examiner rejected claims 8-9 under 35 U.S.C. § 102(e) and rejected claims 1-6 under 35 U.S.C. § 103.

As indicated above, claims 1, 4 and 8-9 have been amended for stylistic reasons and in order to make explicit what is implicit in the claims. The amendment is unrelated to a statutory requirement for patentability.

Claims 8 and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Ellis, et al.* (U.S. Publication No. 2003/0149988).

Ellis, et al. appears to disclose that it is not desirable to record a program unless a certain number of users have requested it. If not enough users have requested the program, a message is generated and sent back to the distribution equipment to inform the users. The program guide may notify the users that the program is not being recorded. Alternatively, the program guide may request that the program be recorded by a local media server or may record the program itself on a storage device [0086, emphasis added].

Thus, *Ellis, et al.* only discloses determining whether enough users have requested that a program be recorded. Nothing in *Ellis, et al.* shows, teaches or suggests a determination portion configured to determine whether a storage portion contains sufficient space to record a program requested to be recorded and/or reserved as claimed in claim 8. Rather, *Ellis, et al.* only discloses determining if sufficient users have requested recording a program.

Furthermore, since *Ellis, et al.* only discloses a program may be recorded by a local media server or may be recorded on a storage device, nothing in *Ellis, et al.* shows, teaches or suggests a recording substitution portion replacing advertising content with new advertising

content or inserting additional advertising content into a recorded program in a storage portion as claimed in claim 9. Rather, *Ellis, et al.* merely discloses a program guide may request a program be recorded by a local media server or may record the program itself on a storage device.

Finally, since *Ellis, et al.* only discloses not recording a program when insufficient numbers of users have requested it be recorded, nothing in *Ellis, et al.* shows, teaches or suggests an issue portion configured to issue a recording substitution request to an external device automatically in response to the storage portion containing insufficient space as claimed in claim 8. Rather, *Ellis, et al.* merely suggests that program guide may request the program be recorded by a local media server or may record the program itself.

Since nothing in *Ellis, et al.* shows, teaches or suggests (a) determining whether a storage portion contains sufficient space to record a program and issuing a recording substitution request to an external device automatically in response to the storage portion containing insufficient space as claimed in claim 8, and (b) a recording substitution portion replacing advertising content with new advertising content or inserting additional advertising content into a recorded program in a storage portion as claimed in claim 9, Applicants respectfully request the Examiner withdraws the rejection to claims 8 and 9 under 35 U.S.C. § 102(e).

Claims 8 and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Chihara* (U.S. Patent No. 6,678,462).

Chihara appears to disclose determining whether a selected electronic device has sufficient recording capacity. If not, a determination is made whether another electronic device has sufficient capacity. If no electronic device has sufficient recording capacity, then recording is impossible (Col. 6, lines 14-26).

Thus, *Chihara* only discloses if one electronic device does not have sufficient capacity, checking capacity of another electronic device. Nothing in *Chihara* shows, teaches or suggests automatically issuing a recording substitution request to an external device when storage space is insufficient as claimed in claim 8. Rather, *Chihara* tests a plurality of devices in order to determine if recording capacity is sufficient and thus, does not automatically issue a recording substitution request to an external device as claimed in claim 8.

Furthermore, nothing in *Chihara* shows, teaches or suggests a recording substitution portion replacing advertising content with new advertising content or inserting additional advertising content into a recorded program in a storage portion as claimed in claim 9. *Chihara* only discloses determining if a plurality of devices have sufficient recording capacity, and if none do, concluding recording is impossible.

Since nothing in *Chihara* shows, teaches or suggests (a) automatically issuing a recording substitution request to an external device when insufficient space is contained in a storage portion as claimed in claim 8 and (b) replacing advertising content with new advertising content or inserting additional advertising content into a recorded program in a storage portion as claimed in claim 9, Applicants respectfully request the Examiner withdraws the rejection to claims 8 and 9 under 35 U.S.C. § 102(e).

Claims 1-2 and 4-6 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* (U.S. Patent No. 6,311,011), in view of *Zigmond, et al.* (U.S. Patent No. 6,698,020).

Kuroda appears to disclose warning a user that a storage device does not have sufficient storage capacity and allows a view a choice to select another storage device (Col. 5, lines 60-67). Nothing in *Kuroda* shows, teaches or suggests issuing a recording substitution request to an external device for recording the program in response to a determination that recording is not

possible as claimed in claim 1. Rather, *Kuroda* only discloses issuing a warning to a user that capacity is insufficient (i.e. a user is not an external device for recording a program and the warning is not a recording substitution request that is issued to an external device).

Furthermore, since *Kuroda* only discloses that a user is warned that the storage device does not have sufficient capacity, nothing in *Kuroda* shows, teaches or suggests a recording substitution means receiving a recording substitution request and receiving and recording a corresponding program in a storage means as claimed in claim 4. Rather, *Kuroda* only discloses warning a user that insufficient capacity for recording is present.

Finally, nothing in *Kuroda* shows, teaches or suggests user information management means (a) inserting advertising information in a recorded program stored in a storage means or (b) substituting for the original commercial information stored in the recording means as claimed in claims 1 and 4.

Zigmond, et al. appears to disclose that during display of a video programming feed, a selected advertisement is displayed at an appropriate time based on a triggering event (Col. 4, lines 36-52). The system may be used to select appropriate advertisements based on whether the video programming feed is watched as a broadcast or replayed from recorded media. Advertisers can thus update time-sensitive advertisements. Furthermore, originally recorded advertisements can be replaced with effectively targeted ads (Col. 14, lines 1-12).

Thus, *Zigmond, et al.* merely discloses that based upon a triggering event in a program feed or from a recorded media during replay, appropriate advertisement is inserted into the displayed program. Nothing in *Zigmond, et al.* shows, teaches or suggests inserting advertising information in a recorded program stored in the storage means in addition to original commercial information or substituted for the original commercial information included in the recorded

program as claimed in claims 1 and 4. Rather, *Zigmond, et al.* only discloses that during the program feed or replay thereof, when a triggering event occurs, appropriate advertising information is displayed. Nothing in *Zigmond, et al.* shows, teaches or suggests inserting the advertising information into a recorded program stored in a storage means as claimed in claims 1 and 4. *Zigmond, et al.* only discloses displaying appropriate advertisements and not storage thereof.

A combination of *Kuroda* and *Zigmond, et al.* would merely suggest that a user is warned when a storage device contains insufficient storage capacity as taught by *Kuroda* and that during programming feed or replay (i.e. display of the program), when a triggering event occurs, advertisement is selected and displayed as taught by *Zigmond, et al.* Thus, nothing in the combination of the references shows, teaches or suggests (a) issuing a recording substitution request to an external device for recording a program in response to the impossibility of recording a program as claimed in claim 1, (b) receiving and recording a program in a storage means in response to reception of a recording substitution request as claimed in claim 4, and (c) inserting or substituting advertising information in a recorded program stored in a storage means as claimed in claims 1 and 4. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 1 and 4 under 35 U.S.C. § 103.

Claims 2 and 5-6 depend from claims 1 and 4 and recite additional features. Applicants respectfully submit that claims 2 and 5-6 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda* and *Zigmond, et al.* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 2 and 5-6 under 35 U.S.C. § 103.

Claim 3 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda*, in view of *Zigmond, et al.*, and further in view of Applicants' Admission of Fact.

Applicants respectfully traverse the Examiner's rejection of the claim under 35 U.S.C. § 103. The claim has been reviewed in light of the Office Action, and for reasons which will be set forth below, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

Applicants note that official notice was taken that it is well known to include redundant storage devices when a given storage device is not working or failing. However, the Examiner has not indicated how a failure in a system will result in determining that it is impossible to record when the system prevents a program from being recorded in a storage means as claimed in claim 3. Furthermore, since nothing in the primary references shows, teaches or suggests the primary features as claimed in claim 1, Applicants respectfully submit that the combination of the primary references with the official notice will not overcome the deficiencies of the primary reference. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 3 under 35 U.S.C. § 103.

Thus, it now appears that the application is in condition for a reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested. Should the Examiner find that the application is not now in condition for allowance, Applicants respectfully request the Examiner enters this amendment for purposes of appeal.

CONCLUSION

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 05-0320.

Respectfully submitted,

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